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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/313,534 05/13/99 ROMERO

A	4530-P-RE
EXAMINER	

HM12/0310

BRUCE STEIN  
INTELLECTUAL PROPERTY LEGAL SERVICES  
PHARMACIA & UPJOHN COMPANY  
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ART UNIT	PAPER NUMBER
MORRIS, P	4

DATE MAILED: 1612

03/10/00

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-8 is/are allowed.
- ☒ Claim(s) 9-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Art Unit: 1612

*Reissue Applications*

Claims 1-12 are pending in this application.

The reissue oath or declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and see MPEP 1414.

The reissue statute - 35 U.S.C. 251 - provides for the reissue of patents whenever the patent is deemed wholly or partly inoperative or invalid through error without any deceptive intention. Applicant fails to allege that the original patent is inoperative or invalid or fails to state the reason of a defective specification, or of patentee claiming more or less that patentee had the right to claim in the patent.

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Art Unit: 1612

Applicant has presented claims 9-12 to multiple inventions that had not been originally claimed and could have been claimed elsewhere. Reissue applicants' failure to timely file a divisional application is not considered to be error causing a patent granted on claims to be partially inoperative by reason of claiming less than they had a right to claim. Failure to file divisional subject matter is not recoverable by reissue.

Claims 9-12 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

Claims 9-12 are rejected under 35 U.S.C. 251 as being drawn to inventions not claimed in the original patent as evidenced by the claims in the original patent.

As noted by the Court in In re Orita, 550 F 2d 1277, 193 USPQ 145 (CCPA 1977):

“Section 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney, and the case at bar exemplifies a mistake which this section cannot cure.”

Applicant's claims are drawn to multiple, patentably distinct inventions that will support separate patents. Reissue applicant's failure to timely file a divisional application is not considered to be error. This is not correctable by reissue of the original patent under 35 U.S.C. 251.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Art Unit: 1612


*Allowable Subject Matter*

Claims 1-8 are allowed.

*Conclusion*

Claims 9-12 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

March 9, 2000